

Appl. No. : **10/695,683**
Filed : **October 29, 2003**

REMARKS

Prior to the filing of this paper, Claims 1-33 were before the Examiner for consideration in this application. Applicant had previously withdrawn Claims 34-36 in response to the Restriction Requirement electronically delivered March 14, 2007. In this paper, Claims 1, 17, and 24 have been amended, new claims 37-42 have been added, and claims 34-36 have been canceled. No new matter has been added with these amendments.

Telephonic Interview

Applicant wishes to thank the Examiner and Supervising Examiner for conducting a helpful telephonic interview on August 7, 2007. A summary of the telephonic interview is provided in the above section entitled "Summary of Interview."

Summary of the Office Action

In the Office Action electronically delivered May 10, 2007, the Examiner rejected Claims 17-21 under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim certain subject matter. The Examiner also rejected Claims 1, 3, 4, 6, 8, 9, 11-13, 17, 18, and 22-32 as being anticipated by U.S. Patent No. 5,509,708 to Nathan. The Examiner rejected Claims 2, 5, 7, 10, 14-16, and 19-21 under 35 U.S.C. § 103(a) as being unpatentable over Nathan. The Examiner also rejected Claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Nathan in view of U.S. Patent No. 6,658,743 to Dudley, Jr. et al.

Rejection under 35 U.S.C. § 112

The Examiner rejected Claims 17-21 under 35 U.S.C. § 112. Particularly, the Examiner indicated that there is improper antecedent basis for the limitation "the rearward portion" in line 2 of Claim 17. Claims 18-21 depend from Claim 17, and appear to have been rejected solely based on this dependency. Applicant has amended Claim 17 to introduce "a rearward portion" in Claim 17, thus providing antecedent basis for this term. Accordingly, this rejection is now moot with respect to Claim 17 and Claims 18-21, which depend therefrom. Applicant respectfully requests that the Examiner withdraw this rejection.

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Rejections based on Nathan (U.S. Patent No. 5,509,708)

The Examiner rejected Claims 1, 3, 4, 6, 8, 9, 11-13, 17, 18, and 22-32 as anticipated by Nathan, and Claims 2, 5, 7, 10, 14-16, 19-21, and 33 under 35 U.S.C. § 103(a) as being unpatentable over Nathan or Nathan in combination with Dudley. For at least the reasons below, Applicant believes these rejections should be withdrawn.

Nathan discloses a handle for carrying objects which can be used as a “knuckles” for self-defense. (Col. 1, lines 5-8). The Nathan device includes a handle with an opening through which a user puts all of the fingers of a hand. (Col. 1, lines 53-57; Fig. 1). A row of squared nodules (4) cover and enclose the user’s fingers, and can be used as knuckles for self defense. (Col. 2, lines 8-10, 25-56; Figure 1).

The device disclosed in Nathan appears to be a type of “brass knuckles” device, which are illegal in many states and identified as security risks, subject to possible confiscation, at various security screenings for travel, attendance at public events, entry into concert or sporting venues, or the like. In contrast, embodiments of the devices disclosed and claimed in the present application include various features aimed at, among other goals, allowing them to be carried at substantially all times and anywhere, including through security screenings for transportation services, and sports and concert venues.

Claims 1-23

In contrast to the finger-enclosing Nathan device, Claim 1 of the present application recites a personal defense device including, among other limitations a plurality of “open-sided recesses configured to receive fingers of the user.” Nathan, which covers a user’s fingers with nodules to provide “knuckles” does not disclose open-sided recesses. During the interview, the Examiner indicated that the recitation of open-sided recesses would overcome the rejections based on Nathan. To further distinguish Claim 1 from the recited art, Applicant has further amended Claim 1 to recite that the device is capable of receiving fingers placed in the recesses “such that they *are uncovered on one side.*” (emphasis added). Additional clarifying amendments have also been made to Claim 1. Accordingly, Claim 1 is allowable over the cited art.

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Claims 3, 4, 6, 8, 9, 11-13, 17, 18, and 22-23 were also rejected by the Examiner as anticipated by Nathan. These claims all depend from Claim 1 and recite additional unique limitations thereon. They are thus allowable for at least the reasons discussed above with respect to Claim 1.

Claims 2, 5, 7, 10, 14-16, and 19-21 were rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Nathan. These claims all depend from Claim 1 and recite additional unique limitations thereon. However, Nathan does not disclose or suggest the device recited in Claim 1. As noted above with respect to Claim 1, Nathan fails to disclose open-sided recesses. Instead, Nathan teaches away from having “open-sided recesses” by indicating that in the disclosed device, squared nodules covering a user’s hand are used as knuckles for self defense. (Col. 2, lines 25-26). Accordingly, Nathan fails to disclose or suggest (and in fact, teaches away from) the inventions recited in Claims 2, 5, 7, 10, 14-16, and 19-21. Applicant therefore respectfully submits that these claims are allowable.

Claims 24-33

In contrast to the finger-enclosing Nathan device, Claim 24 of the present application recites a personal defense device including, among other limitations, an elongate shaft having a forward, finger receiving side comprising “a plurality of open-sided recesses.” As noted above with respect to Claim 1, the Nathan knuckles device completely encloses the fingers of a user and thus fails to disclose open-sided recesses. During the interview, the Examiner indicated that the recitation of open-sided recesses with respect to Claim 1 would overcome the rejections based on Nathan. To further distinguish Claim 24 from the recited art, Applicant has further amended Claim 24 to recite that the device is capable of receiving the forefinger through the opening with other fingers placed in the recesses on the finger receiving side and “*uncovered* on the opposite side.” (emphasis added). Further clarifying amendments have also been made to Claim 24. Accordingly, Claim 24 is allowable over the cited art.

Claims 25-32 were also rejected as being anticipated by Nathan. These claims all depend from Claim 24 and recite additional unique limitations thereon. They are thus allowable for at least the reasons discussed above with respect to Claim 24.

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Claim 33 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Nathan in view of Dudley. Claim 33 depends from Claim 24 and recites additional unique limitations thereon. However, the combination of Nathan and Dudley suggested by the Examiner neither discloses nor suggests the device recited in Claim 24. As noted above with respect to Claim 24, Nathan, Nathan fails to disclose open-sided recesses. Instead, Nathan teaches away from having “open-sided recesses” by indicating that in the disclosed device, squared nodules covering a user’s hand are used as knuckles for self defense. (Col. 2, lines 25-26). Dudley relates to a skinning knife and lacks many of the limitations recited in Claim 24 (for example, “a protrusion” *at the distal end* of an elongate shaft).

However, the Examiner asserted that the Nathan device could be modified to include a protrusion with a blunt tip based on the disclosure of Dudley, which includes a knife blade with a gut hook having a blunt tip. (Col. 3, lines 66-67). Even if the modification asserted by the Examiner were made, the device would still completely enclose the fingers of a user. Furthermore, although not suggested by the Examiner, if the Nathan knuckles device were modified to include the grip of the Dudley knife, the resulting combination would lack many features recited in Claim 24 (for example, a protrusion at the distal end of an elongate shaft), and would cease to function as a defense device.

Furthermore, given the nonanalogous nature of the technical areas, one of skill in the art would not look to knife art (such as Dudley) for hand and finger grip designs when seeking to modify a knuckles device (such as Nathan). The different hand motions used in defending ones self with a knife versus a knuckles device create needs for hand protection of different configurations and at different locations in these two types of devices. Therefore, one of skill in the art would not expect to achieve success in a knuckles-type device by adapting the handgrip from a knife device. Additionally, one seeking to develop a hand-held personal defense device that can be carried at substantially all times and through security screenings would be unlikely to turn to knife art as knives are likely to be banned items at most security screenings.

Accordingly, the combination of Nathan and Dudley fails to disclose or suggest (and in fact, teaches away from) the subject matter recited in Claim 33. Applicant therefore respectfully submits that Claim 33 is allowable.

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New Claims 37-42

Applicant has added Claims 37-42, which depend from one of Claims 1 and 24 and recite additional limitations thereon. No new matter has been added. These claims are therefore allowable for at least the reasons described above with respect to Claims 1 and 24.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance. Furthermore, any remarks in support of patentability of one claim should not be imputed to any other claim, even if similar terminology is used. Any remarks referring to only a portion of a claim should not be understood to base patentability on that portion; rather, patentability must rest on each claim taken as a whole. Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches, even if not expressly discussed herein.

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or prior art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

The undersigned has made a good faith effort to respond to all of the rejections in the case, and to place the claims and conditions for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

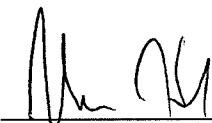
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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AMEND 4106189 / 080707